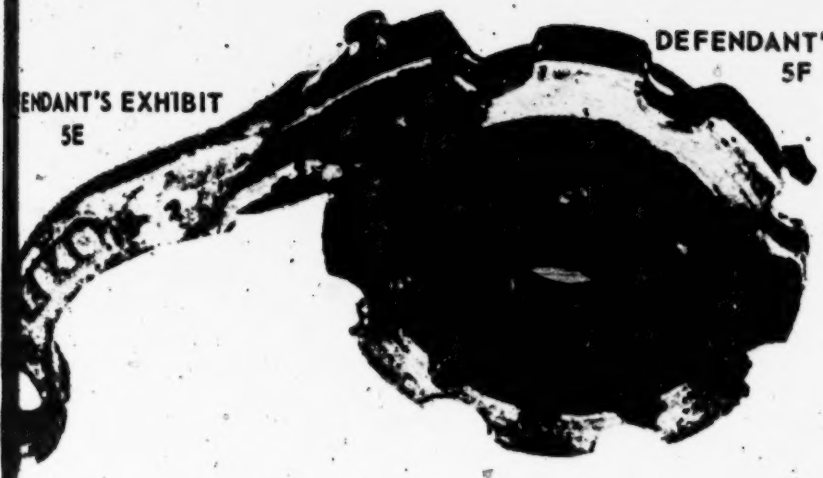
The International Harvester Company used these holders on its 50T baler which it manufactured and sold from 1944 to 1952 inclusive.

Another large agricultural implement manufacturer, the New Holland Machine Division of the Sperry Corporation of New Holland, Pennsylvania, adopted a similar two-finger holder on its twine tie balers in 1948, and it is still using them. The following is a photograph of Defendant's Exhibit 5G, which is one of these holders:

DEFENDANT'S EXHIBIT
5G

Massey-Harris Company, now Massey-Ferguson, Inc., of Racine, Wisconsin, another sizable agricultural implement company, manufactured and sold its Model No. 6 Corn Binder, in substantial quantities, in the years 1935-1945, with twine holders such as shown in the following photograph of Defendant's Exhibit 5E. This is a triple element holder in which the holder elements are bridged, cooperating with the disks as shown in the following photographs:

DEFENDANT'S EXHIBIT
5E



Mr. England, the plaintiff here, a farmer doing hay baling on his own farm and also doing custom baling, had International Harvester 50T balers, purchasing his first in 1947 or 1948 and a second in 1950. In endeavor for tighter bales for himself and his customers, he tried various adjustments and improvised changes until, in August 1950, he thought to add, to the International Harvester two-finger holder, a third finger, and that gave improved results in that regard (DA 16-20).

The following year, October 15, 1951, Mr. England applied for patent. The prosecution of the application will be treated in the following section, based on the exhibit Patent Office file history. The application, as amended, was allowed, and the patent went to issue (No. 2,594,140) on April 22, 1952, with six claims.

Defendant, Deere & Company, began its development of a twine-tie baler at its product development department, in Moline, Illinois, prior to 1953. In 1953, it was transferred to the Ottumwa (Iowa) plant for production engineering. Proposing to use a three element twine holder, Ottumwa consulted the patent department at Moline, and that department (in charge of Mr. C. T. Parker, General Patent

Attorney for Deere), upon investigation and finding said England Patent No. 2,594,140, reported back that, in its opinion, the patent was invalid (DA 61-63).

Deere began sale of twine-tie (14-T) balers June 1, 1954 (DA 13), and, on June 2, 1954, Mr. Parker wrote to Mr. England (first letter of Defendant's Exhibit H) as follows:

> "Our engineers at Ottumwa tell us that you have notified them that your patent, No. 2,594,140, dated April 22, 1952 is infringed by the twine holder furnished on our No. 14T baler.
>
> We carefully studied your patent before our factory went into production on these holders and found that you are not the first inventor of the triple blade holder working with a double disk. The idea is disclosed in two Cooley patents, No. 345,674 dated July 20, 1886 and No. 352,081 dated Nov. 2, 1886.
>
> In view of these old patents, any claims of your patent that we might infringe are invalid. For this reason we and all other manufacturers are free to use the triple blade twine holder without liability.
>
> If, after studying these Cooley patents, you disagree with our opinion, please feel free to let us know wherein we differ."

On June 29, Mr. Mason, attorney for Mr. England, wrote Mr. Parker contending that the holding elements of the Cooley patent were "ribs," "not fingers" (second letter of Defendant's Exhibit H), and inviting reply. Mr. Parker replied on July 2, fully and thus promptly in explanation of his position (third letter of Defendant's Exhibit H): there was no reply from Mr. Mason.

And Deere continued its manufacture and sale of its 14-T baler.

On January 18, 1955 the Reissue Patent 23,927 (the patent in suit) issued, revealing that application therefor had been applied for, with added narrowed claims, on Septem-

ber 23, 1954. The prosecution of that application will be treated in the following section, based on the exhibit Patent Office file history.

On March 28, 1955, other attorneys for Mr. England opened the subject of that patent with Deere's Mr. Parker, proposing a meeting looking toward a settlement, and further correspondence ensued (Defendant's Exhibit H); but nothing came of that, as the letters show, and the Complaint was filed November 28, 1956.

The pleadings included counterclaim by defendant for affirmative relief on the ground of invalidity of the patent in suit, depositions were taken, stipulations of fact and for procedure were entered into, and the case went to trial in April 1959; briefs were filed, oral argument was had, and the Opinion and Judgment of the District Court (DA 92-110) were handed down March 28, 1960, finding the cited patent claims valid and infringed; and formal Judgment was entered April 18, 1960 (DA 111-112), on which day Notice of Appeal was filed (DA 113) by defendant.

The formalities in the Court of Appeals were duly complied with, briefs and appendices were filed, including reply brief by defendant-appellant, the case went to hearing on October 19, 1960, and the Court of Appeals handed down its Opinion and affirming Judgment on November 28, 1960 (App. 21-28); Petition for Rehearing was filed by defendant-appellant on December 13, 1960; plaintiff-appellee filed Answer to Petition for Rehearing on December 27, 1960; and defendant-appellant's Petition for Rehearing was denied on January 18, 1961; defendant-appellant petitioned for stay of mandate on January 20, 1961, and stay of thirty (30) days from January 18, 1961, was granted on January 25, 1961.

REASONS FOR THE ALLOWANCE OF THE WRIT.

Whenever it is a reissue patent that is the basis for a patent infringement suit, the reason for the reissue, under the exacting limitations of the statute, is of fundamental and substantive concern, and this is specially so where the defendant was previously accused under the original patent.

The instant case involves what petitioner contends is a misuse by respondent of the reissue patent statute (35 U. S. C. Sec. 251), now standing approved in the instant case by the Courts below, and also the application, by the Courts below, of criteria of invention in conflict with applicable decisions of this Court.

In treating these subjects here, we predicate what we have to say on the preceding Statement of the Case, the Patent Office file histories of the two England patent applications, including the two patents themselves (DA 115-122), and the Opinions and Judgments of the Courts below, those of the District Court at DA 92-110 and that of the Court of Appeals being reprinted on Pages 21-28 of the Appendix to this Petition.

It is significant that, although the International Harvester two-finger holder was Mr. England's direct and immediate prior art, *there is no mention of it in his patent specification.* Rather, he leaves it as if he were the first to pluralize holder elements, as follows (Patent in suit, Col. 1, lines 72-78):

> "It has heretofore been customary to use a twine holder having a single finger received in the space between the entraining wheels 16 and 18. The present invention provides a twine holder arm 30 having a plurality of fingers including a central finger 32 which passes between or is received in the space be-

tween the entraining wheels 16 and 18 for the customary purpose of forcing the twine down in and between the disks where it is frictionally held."

Reference is made to Defendant's Exhibit 6B, the file wrapper and contents of England Patent 2,594,140, of which Page 6 contains the four claims originally filed, and Page 16 contains the Examiner's action thereon, Claims 1, 2 and 3 "as obviously fully met by the disclosure in Hornsby *et al.* See Fig. 17" and Claim 4 "as unpatentable over the disclosure in Hornsby *et al.*"

That is the Hornsby British Patent 11,419 of 1888, which shows disks and holders of various kinds, and its Figure 17 shows a holder such as the Massey Harris holder just above referred to. Incidentally, this is also substantially the same as the holders of the Cooley patents which Mr. Parker cited to Mr. England.

In the amendment paper in response (Pages 17-20 of the exhibit), the applicant deleted Claim 1, and we quote it here:

> "1. A twine holder for a tying machine having a pair of step by step twine engaging disks, a twine holder having a presser finger entering between said disks and a pair of fingers mounted in spaced parallel relation to said presser finger, said pair of fingers embracing the outer sides of said twine engaging disks."

The applicant thus acknowledged that "finger" does not alone distinguish from the Hornsby Figure 17 holder.

The amendment substitutes a claim which became Claim 4 of the patent (one of the three original patent claims in issue here). That claim characterizes the fingers as "plate-like" and adds a further limitation, which incidentally is also shown by Hornsby. No function in omitting the bridge is either taught by the England specifica-

tion or asserted in the Remarks attending the amendment. If "plate-like" is to mean anything, the same would, of course, apply to the International Harvester and the New Holland holders, but they were not of record in the Patent Office.

Claims 2 and 3 of the application were amended and became Claims 1 and 2 of the patent (the other two original patent claims in issue here). Claim 1 states that the fingers are "plate-like."

It is appropriate here to refer to the holdings of the Courts below to the effect that the International Harvester and the New Holland two-finger holders were cited to the Examiner.

They did not hold that they were cited to the Examiner during the pendency of the original England application, but did so hold in regard to the application for reissue, this on the ground that the attorneys for England had filed a piece of his advertising matter listing a number of balers on which his holders could be used. This piece of advertising matter is shown at the lower right hand corner of Page 66 of plaintiff's Appendix, and it will be seen that International 50T and New Holland balers are listed, but there is nothing whatever there about their factory-installed twine holders. Yet the District Court, who regarded the International Harvester holder as "the device which most closely anticipates plaintiff's claimed invention" (DA 103) said (DA 108) that the Mr. England's patent

> "was issued to him by the Examiner over the teachings of the pertinent prior art references, and over the prior usage by International Harvester and New Holland which were cited to the Examiner."

On this subject, the Court of Appeals said (App. 27):

> "Defendant lays much emphasis on its argument that the prior usage of two-finger holders by Interna-

tional Harvester and New Holland were not before the examiner. The trial court found to the contrary. The record shows that in Paper No. 3 of the Reissue Patent, the examiner was informed that plaintiff's holder was for use on the International Harvester 50 T baler and on the New Holland baler, among others, in place of the factory-installed holders.

In retrospect, it might have been better to have explained in detail the device used on these balers. It seems reasonably certain, however, that the claims of the patent both as originally presented and as the examiner finally allowed, were drawn to and read over this prior and current usage."

We take it that this last sentence means to say that the claims were drawn to distinguish from the International and New Holland prior uses, and he who wrote the claims, knowing of these prior uses, did that in terms by specifying three fingers, but, with no disclosure of those prior uses in the Patent Office record, it can not be said that the Examiner allowed the claims taking these prior uses into consideration.

There is no substantive presumption of validity of Claims 1, 2 and 4, based on what was determined by the Patent Office Examiner.

As to the reissue matter:

If the original claims were valid, why the reissue?

Here is what plaintiff says in his brief in the Court of Appeals:

"On page 41 of Defendants' Brief, Defendant assumes that if Mr. England regarded the claims of his original patent as valid and infringed by Deere, he would have filed suit rather than to apply for a re-

issue. With this assumption, Plaintiff must disagree. It is almost axiomatic in the practice of law that a court action should be considered as a last resort. It is always advisable to effect a settlement if at all favorable in preference to last ditch litigation. Lawsuits are costly. They detract from victory and add to the burden of defeat. The Plaintiff might well have thought it preferable to place his patent again on the firing line in the Patent Office and expose it to Deere's objections, *inter alia*, rather than to jump into a lawsuit. And without the benefit of hindsight, who could say but that Deere might have a change of heart if the patent was reissued *in an improved form*. Moreover, Defendant's actions were clearly the proximate cause of Mr. England's *reassessment* of his patent protection." (Italics ours.)

The reissue statute (35 U. S. C. Sec. 251) is not for a new patent "in an improved form" or for "reassessment" of patent protection. The statute has no provision for anything like that. The reissue statute is for curing inoperativeness or invalidity by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent.

The District Court said (DA 102):

"The further contention that the reissue patent must be declared invalid because all of the original claims are retained therein must be rejected. If a reissue patent must be stricken down on that basis alone, the reissue statute may well be impliedly repealed insofar as it provides for the correction of a patentee's having claimed *less* in his original application than he was entitled to claim." (Italics ours.)

To the contrary of the District Court's appraisal of the matter, it was not the purpose of the reissue application to *enlarge* the scope of the patent; the purpose was to *limit* the scope of it to save it if possible.

In its Decision (App. 28) the Court of Appeals states that:

> "this is not a case where the patentee admits he claimed more than he was entitled to in the original patent. It was plaintiff's objective to correct defects in the specification."

That was the objective alleged in plaintiff's reissue application affidavit, but the explanation above quoted from his brief in the Court of Appeals is something entirely different.

We say that the purpose of applying for reissue was to have claims as specific as possible and still read on the Deere holder and to accomplish that without sacrificing Claims 1, 2 and 4 in order to thwart intervening rights on the part of Deere. Hence the resort to alleged "defects" in the specification and the pretense of correcting them. The three inserts in the specification are sterile. They would not be permitted unless the drawings themselves said the same thing, and that being so, if they were stricken it would leave no defect.

Claims 1, 2 and 4 can only be treated broadly. Under the doctrine of differentiation of claims, these claims can not now, in the presence of the added reissue claims, be construed narrowly to mean completely separated fingers, which is the specific characteristic recited in all of the added claims.

Under the law, Claims 1, 2 and 4 can not be construed as so limited:

Symington Co. v. *National Castings Company*, 250 U. S. 383, 385.

Cameron Iron Works v. *Stekoll*, 242 Fed. 2d 17, 21.

Landis Machine Co. v. *Parker-Kalon Corporation*, 190 Fed. 2d 543, 544.

Stearns v. *Tinker & Rasor*, 252 Fed. 2d 589, 597.

All of the claims added by reissue (7 to 12, inclusive) differ from original Claims 1, 2 and 4 by reciting that the fingers are completely separated from each other along their longitudinal edges.

As an example, reissue Claim 9 was derived from original Claim 4, and the following shows the difference

> 9. A twine holder for use in a tying machine having a pair *of spaced, apart* step by step twine engaging disks; said twine holder comprising a supporting arm having means adjacent one end for pivotally mounting the same *on said tying machine* and having a plate-like central presser finger extending therefrom and a pair of plate-like fingers mounted in spaced relation to said first presser finger, said pair of fingers having their adjacent longitudinal edges in the form of arcs, *and means rigidly mounting said pair of plate-like fingers on said arm, the said fingers being completely separated from each other along the longitudinal edges of each finger.*

The italicised phrases are the reissue additions. The one at the end is, of course, the material one, and it is clear that what is there set forth is also true of the prior International Harvester and New Holland holders. All of the other reissue claims have equivalent phrases.

It is petitioner's position that original Claims 1, 2 and 4 are met by the bridged twine holders of the cited prior patent art and the prior Massey-Harris holder, and that, in view of the prior International Harvester and New Holland holders, all the reissue claims must fall for non-compliance with the criteria of invention established by this Court.

Dunbar v. *Myers*, 94 U. S. 187.
Atlantic Works v. *Brady*, 107 U. S. 192.
Cuno Corporation v. *Automatic Devices Corporation*, 314 U. S. 84.

Great Atlantic & Pacific Tea Co. v. *Super-Market Equipment Corporation*, 340 U. S. 147.

It is also pertinent to refer to the ruling of the Court of Appeals in the instant case, where there was public use and sale of the subject matter of the reissue claims more than one year prior to the reissue application (DA Pages 23-24, 28, 72-73, and Plaintiff's Exhibit 3), in comparison with its previous ruling, on the same state of facts in the case of *Crane Packing Company* v. *Spitfire Tool & Machine Co.* (276 F. 2d 271, 274), cited in Defendant-Appellant's Brief. In the earlier case, the Court held such facts to be invalidating; here, the Court ruled that defense to be without merit (App. 28).

It is respectfully submitted that it is in the public interest that the patent reissue statutes, in the respects applicable here, be considered and their interpretation determined by this Court, that the applicable criteria of invention and patentability established by this Court be applied, and, accordingly, that this petition for a writ of certiorari should be granted.

Respectfully submitted,

ARTHUR H. BOETTCHER,
CAMERON A. WHITSETT,
EDWARD C. GRELLE,
Attorneys for Petitioner.

APPENDIX.

STATUTES INVOLVED.

"SECTION 251. *Reissue of defective patents.*

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of a patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent. (R. S. 4916; 35 U. S. C., 1946 ed., 64.)"

"SECTION 252. *Effect of reissue.*

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue. (R. S. 4916; 35 U. S. C., 1946 ed., 64.)"

OPINION.

IN THE UNITED STATES COURT OF APPEALS

for the Seventh Circuit.

No. 13029 September Term and Session, 1960

JOHN W. ENGLAND,
Plaintiff-Appellee,

vs.

DEERE & COMPANY,
Defendant-Appellant.

Appeal from the United States District Court for the Southern District of Illinois, Northern Division.

November 28, 1960.

Before DUFFY, SCHNACKENBERG and KNOCH, *Circuit Judges.*

DUFFY, *Circuit Judge.* This is a suit for the alleged infringement of Reissue Patent No. 23,927, issued January 18, 1955. All of the claims of this patent, except Claims 3, 5 and 6, are at issue in this suit.[1] The District Court found the claims in issue to be valid and infringed.

1. Claim 2 of the patent in this suit is representative of the claims retained from plaintiff's original Patent No. 2,594,140 and reads as follows:

"2. In a tying machine having a pair of spaced apart twine entraining disks, said disks having peripheral twine receiving notches, a twine holder comprising an arm pivotally mounted adjacent the periphery of said disks, a central finger on said arm, said central finger extending between said disks, a pair of fingers rigidly secured in spaced parallel relation to said central finger,

On October 15, 1951, plaintiff filed an application for a patent on the three-finger holder hereinafter described. The application was first denied by the examiner as not constituting invention over the Hornsby et al. British Patent No. 11,419. Several other references also were cited. Upon reconsideration of an amended application, the examiner, applying the same references, reversed himself. Patent No. 2,594,140 containing six claims was issued to plaintiff on April 22, 1952.

After he received his patent; plaintiff began commercial production of the three-finger holder, and the device met with immediate public acceptance. A large number of farmers brought the tying heads of their balers to Mr. England's farm for the installation of his twine holders. Within a space of a few years, the purchasers of twelve thousand of the holders substituted the patented device for the factory-installed equipment on various types of balers. This is a case of the better mousetrap, for the public has beaten a path to Mr. England's door to obtain his holder.

Prior to 1954, defendant, Deere & Co., did not market a twine-tie baler. It had been manufacturing grain and

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said pair of fingers engaging the outer sides of said twine entraining disks, the face of each of said fingers having an arcuate twine engaging surface or edge portion."

Claim 7 is representative of the six new claims added to the patent in suit and reads as follows:

"7. In a twine tying machine having a pair of spaced apart twine entraining rotary disks, said disks having peripheral twine receiving notches; the combination with said machine of a twine holder comprising an arm, arm pivot means pivotally mounting said arm on said machine adjacent the peripheries of said disks, a central plate-like finger extending between said disks, a pair of plate-like fingers, means rigidly securing one end only of each of the fingers of said pair of fingers to said arm with one finger of said pair of fingers on each side of said central finger, the said fingers being completely separated from each other along all of their longitudinal edges and providing open spaces between said fingers whereby the said central finger may freely move between said disks during movements of said arm about said pivot means."

corn binders equipped with a single member twine holder. In 1951, it began experimenting with twine-tie balers. On June 9, 1953, Deere & Co. purchased three sets of plaintiff's holders to be used in its experimental work. Plaintiff personally delivered the holders to defendant. The twine-tie baler manufactured by defendant was placed on the market about June 1, 1954. These Deere machines were equipped with triple-finger twine holders. Plaintiff promptly notified defendant these holders were an infringement of his patent. Defendant replied that the claims of plaintiff's patent were anticipated by Cooley Patents No. 345,674 and No. 352,081.

On September 23, 1954, plaintiff filed an application for reissue of his patent. Six new claims, 7 to 12, inclusive, were added to the six claims of the original patent, all of which were retained. The application stated in the specification: "As seen in Figures 1, 3 and 4, all the longitudinal edges of said fingers are spaced from each other to provide completely open spaces between the fingers." The application specifically invited attention to Cooley Patents No. 345,674 and No. 352,081. On January 18, 1955, the Reissue Patent was issued embodying the six original claims and the six new claims.

The patented device is one element of the tying mechanism for twine-tie hay balers. There are several component parts to the tying mechanism such as interrelated entraining disks which are notched along their periphery to receive and engage a strand of twine; a holder to engage the twine within the entraining disks; a knotting device which fashions a knot in the twine, and a knife which cuts the twine to disengage the bale so that it may be deposited in the field. Usually a tractor furnishes the motive power.

The claimed invention relates to the twine holder. In knot-tying devices on balers and reapers, it had been

customary to retain the cord or twine with which the bales or bundles were tied, in a twine-entraining disk in which a spring-fashioned finger assists in holding the cord or twine in the entraining disk. The twine-holder described in the patent in suit consisted of three plate-like fingers. In earlier designs, this element was a single pivotally-mounted member which engaged the twine between dual-entraining disks and held it fast until the tying-sequence was completed. A later refinement was exemplified by the Hornsby British patent. This showed a rigid-back holder, and operated in a fairly satisfactory manner when bundles of ordinary weight and size were handled. Later, International Harvester Company and New Holland Mechine Division of the Sperry Corporation used a two-blade holder. However, when the tying mechanism was adapted for use on twine-tie balers and heavy bales resulted from green or damp hay, the old forms of holders were not satisfactory. Those baling hay with such devices almost uniformly had the experience that many bales which had not been properly tied due to the failure of the holding mechanism, were thrown out on the field. These bales had to be tied by hand. This procedure caused many exasperating delays.

Plaintiff England is a farmer by occupation. He was also engaged in custom baling. Like other balers, he encountered a high percentage of failure by the baling machine's tying mechanism. He and others tried a number of methods to overcome the deficiencies. What seemed to be the most obvious method was to increase the spring tension of the twine holder against the disk. This was tried but did not remedy the condition.

Plaintiff tried advancing the timing of the twine disk. He reset the needles at both further and closer distances. He changed the notches in the disks. He tried loosening the twine tension. He adjusted the stripper arms of the

twine to be cut sooner or later. He placed the cutting knife at different angles. He made adjustments to the bill hook. However, nothing he tried resulted in the baler turning out solidly packed bales without an undue percentage of untied bales leaving the machine. Others working in the art were also unsuccessful in finding a solution for the problem.

In August, 1950, plaintiff had had a particularly bad day of baling in which he encountered a large number of untied bales. That night he conceived the idea of constructing a plate-like three finger holder to replace the standard equipment on his baler which was equipped with a two-finger holder. He worked throughout the night welding a pair of three-finger holders and installed them on his baler. The result was sensational. In the next day's use, Mr. England encountered no untied bales after the first bale of the day. He continued to use his discovery experimentally on his own baler during the remainder of the 1950 baling season. The use of the new device continued to be successful.

Defendant argues the application for the original England Patent, No. 2,594,140, was cursory, and its allowance ill-advised. In spite of the allowance of the claims by the Patent Office over the Hornsby disclosure, defendant insists the claimed invention was clearly anticipated by Hornsby. Defendant also claims the Reissue Patent was clearly invalid largely for the same reasons it urged the original patent to be invalid. Defendant finds fault with the application for the reissue patent. Defendant also argues the disclosure of the International Harvester two-blade holder was not before the examiner.

On the application for the original patent, the examiner cited references in addition to the Hornsby patent. These were Remy, No. 314,056; British Patent No. 410 to Wilkinson, and British Patent No. 497,474 to Lanz. The

Hornsby and Wilkinson patents show a holder with a continuous back and three ribs which embrace a pair of disks. The Remy patent shows a two-blade holder with rivets along the top. The patent to Lanz disclosed a holder structurally similar to that of International Harvester in that it has two separated fingers. However, the Lanz holder is shown as fitting between two disks rather than straddling a single disk.

At the trial, experts were called by both sides to testify as to the state of the art and the claimed superiority of plaintiff's three-finger holder. Demonstrations were held. Test machines were build by defendant and by plaintiff. Testimony was received as to the result of various tests. One test disclosed that England's three-finger holder had significantly greater holding power than International Harvester's two-finger holder.

After consideration of the tests and demonstrations and of the conflicting testimony offered, the learned trial judge concluded that plaintiff's patent was valid and infringed. There was substantial evidence to support the trial court's findings and conclusions that plaintiff's invention was novel and constituted a significant advance in the art. There was ample evidence to sustain the statutory presumption in favor of the validity of plaintiff's patent. The presumption of validity applies to a Reissue Patent in the same manner as the original Patent. 35 U. S. C. § 252; *Hazeltine Research, Inc.* v. *Avco Manufacturing Corporation*, 7 Cir., 227 F. 2nd 137, 146. In any event, we cannot say the factual determinations of the trial court were clearly erroneous. *Armour & Company* v. *Wilson & Co.*, 7 Cir., 274 F. 2d 143.

Appropriate here is the statement of the Tenth Circuit in *Harris* v. *National Machine Works, Inc.*, 171 F. 2d 85, 88: "Finally, the presumption of validity arising from the granting of the patent by the Patent Office is strength-

ened by the additional presumption arising from the fact that the invention filled a want presented by a new situation, that it entered into immediate use, and that it met with substantial commercial success."

Likewise pertinent is the statement of this Court in *Ray-O-Vac Co.* v. *Goodyear Tire and Rubber Company*, 136 F. 2d 159 (affirmed 321 U. S. 275) where we stated at page 160: "The court found the patent to be valid and infringed. There was considerable oral testimony given as to the wide acceptance of the product immediately following its appearance on the market. * * * Such evidence bore directly upon the plaintiff's contention that the invention was not obvious. * * * The public appraisal of a new article's worth, evidenced by its prompt acceptance, outweighs, in some cases, a volume of opinion evidence given by professional experts."

Defendant lays much emphasis on its argument that the prior usage of two-finger holders by International Harvester and New Holland were not before the examiner. The trial court found to the contrary. The record shows that in Paper No. 3 of the Reissue Patent, the examiner was informed that plaintiff's holder was for use on the International Harvester 50 T baler and on the New Holland baler, among others, in place of the factory-installed holders.

In retrospect, it might have been better to have explained in detail the device used on these balers. It seems reasonably certain, however, that the claims of the patent both as originally presented and as the examiner finally allowed, were drawn to and read over this prior and current usage.

Furthermore, the claim for the invention of the patent in suit from the very first was directed to a holder having three fingers. The holders using two fingers had proved

inadequate when heavy bales were encountered. The use of two-finger holders in twine-tie balers was common knowledge to those working in the art. In view of the new and unexpected result by adding a third finger to the holder in the manner devised by plaintiff, the use of the International Harvester and New Holland two-finger holders would not have been a bar to the issuance of a patent for plaintiff's invention.

It is not now for the plaintiff to prove that all prior art references are overcome. The burden was on the defendant to show lack of inventive distinction. This it has not done. When the fingers had a web or bar on one end, there could not be the play between the fingers as in plaintiff's invention. This flexibility permits each finger individually to seek, of course within limits, a position within the disks compatible with the thickness and condition of the adjoining twine. The conclusion of the examiner that the England holder does represent a significant advance over the prior art has been confirmed by the subsequent events.

Defendant insists that the Reissue Patent must be declared invalid because all the original claims are retained therein. However, this is not a case where the patentee admits he claimed more than he was entitled to in the original patent. It was plaintiff's objective to correct defects in the specification. The six new claims all refer in some way to the changed specification. The right which the patentee had to correct defects in the specification surely gives him the right to include new claims incorporating those corrections.

Defendant has presented other arguments which we have carefully considered but which we believe to be without merit.

Judgment

AFFIRMED.